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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,924	04/12/2001	Yasuo Iwasa	204985US0CONT	5237

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ALEXANDRIA, VA 22314

EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplementary
Office Action Summary

Application No.

09/832,924

Applicant(s)

IWASA ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The Examiner has carefully considered Applicants' after final amendments and remarks filed on 6/21/2004. It is noted that there is an apparent error in the prior Office action mailed 1/21/2004, i.e., while the Office Action Summary (PTOL-326) correctly indicated that claims 1, 2 and 5-30 (claims 3 and 4 have been cancelled) are rejected, the headings of rejection in section 4 (page 2) stated that claims 1-6 and 19 are rejected, and also the rejection of claims 7-18 and 20-30 are inadvertently not repeated. The Examiner apologizes for the inadvertent error, and as such this Supplemental Office action is required. The after final amendments are not entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Response to Amendment

4. Claims 1, 2, 5, 6 and 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 53081578A (Derwent Abstract), substantially for the reasons set forth in sections 3 and 5 of Paper No. 8, together with the following additional observations.

The Examiner repeats the section 4 of Office action mailed 1/21/2004 as follows:

It is noted that amended (11/24/2003) claim 1 recites in part "wherein a surface of said porous resin film has a contact angle to water of 110° or less and a difference

between a maximum value and a minimum value of said contact angle to water is 30° or less”.

With respect to Applicants' response (11/24/2003) arguing that “JP '578 fails to disclose or suggest a contact angle of the disclosed polyolefin to water of 110° or less and a difference between a maximum value and a minimum value of said contact angle to water is 30° or less” (Remarks, page 8, third paragraph), the Examiner repeats (see Paper No. 8, page 3) that JP '578 expressly teaches that the porous polyolefin tape has excellent printing and painting properties (Abstract). Since a high contact angle is inherently necessary for good printing and painting properties, it is believed that a suitable water contact angle is either inherently disclosed by JP '578, or an obvious modification to one skilled in the art, motivated by the desire to provide a suitable surface wetting property with for good printing and painting properties.

With respect to Applicants' argument (11/24/2003) that JP '578 discloses in Example 1 a difference between a maximum value and a minimum value of the contact angle to water is 41°, which does not satisfy the condition of 30° or less of newly amended claim 1 (Remarks, page 8, bottom paragraph), the Examiner notes that nowhere in JP '578 there is a teaching that Example 1 is a limiting example. Further, it should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

5. Claims 7-11, 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 53081578A (Derwent Abstract) either taken individually, or in view

of JP 2001-019830 (English translation), substantially for the reasons set forth in sections 6 of Paper No. 8, together with the additional observations as set forth above.

6. Claims 12-18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 53081578A (Derwent Abstract), substantially for the reasons set forth in sections 7 of Paper No. 8, together with the additional observations as set forth above.

7. Claims 21-26, 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 53081578A (Derwent Abstract) in view of Ohba et al. (US 5233924), substantially for the reasons set forth in sections 7 of Paper No. 8, together with the additional observations as set forth above.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Victor S Chang
Examiner
Art Unit 1771

7/8/2004



TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700